

REMARKS

Reconsideration of the pending application is respectfully requested on the basis of the following particulars.

1. Election/Restriction

In view of the withdrawal of claim 37 as being directed to a non-elected invention, claim 37 is cancelled herein.

2. In the claims

The pending claims are amended in their preamble to indicate that the set of panels are “packaged.” This amendment is intended to place emphasis on the claimed subject matter of the invention which is a set of floor panels which are in a packaged condition.

From this amendment, it should be readily understood that the invention pertains to “a packaged set of floor panels” and not just a set of floor panels. While the set of floor panels are now referred to in the preamble as being “packaged,” the body of limitations of claim 24 clearly requires that the individual floor panels having at least two different types are packaged in a single box. Accordingly, the limitation “packaged” in the preamble does indeed have a limiting effect on the claim, and should not be dismissed as non-limiting. Moreover, the inclusion of “packaged” throughout all of the pending claims emphasizes this inventive aspect of the pending claims.

Contrary to the assertion in the action that “[P]ackaging the same in a single box or in several boxes or in a different type of container has no bearing on the patentability of the floor panels,” the applicant submits that packaging the required set of floor panels in a single box does have a bearing on patentability of the pending claims. Indeed, the individual floor panels are sized and configured relative to one another so that they can be provided in the recited single box while making it possible for these particularly recited floor panels to form part of “one and the same” floor covering.

This amendment to the claims does not detract from the claimed subject matter examined and discussed in the first Office action dated on June 8, 2006. It will be pointed out that the originally-examined claims require that the set of floor panels are provided in a "single package." Accordingly, the amendment to the claims maintains the claims so that they pertain to the originally presented invention.

Claim 37 is likewise amended to particularly recite as a limitation that the set of panels are configured to form together at least part of one and a same floor covering. This limitation was originally provided in the preamble of claim 24 with the exception that the set of panels need not form the entirety of a particular floor covering. By indicating "part of one and a same floor covering," this limitation connotes that all of the panels in the set are usable together in a single floor covering, but one must not need to form the entire floor covering with the set of the panels.

As mentioned above, claim 37 is cancelled without prejudice or disclaimer.

Entry of the amendment to the pending claims is respectfully requested in the next Office communication.

3. Rejection of claims 24-36 under 35 U.S.C. § 103(a) as being unpatentable over U.S. patent 3,641,730 (*Meckstroth*) in view of U.S. patent 3,350,827 (*Sugar*), U.S. patent 6,256,952 (*Fahy*), U.S. patent 6,863,768 (*Haffner*) and U.S. patent 4,479,333 (*Hendrich*)

Reconsideration of this rejection is respectfully requested in view of the remarks submitted in the appeal brief submitted on August 20, 2007, and the previous reply filed on February 27, 2008, incorporated herein by reference, the amendment to the claim 24 from which the remaining claims depend, and the following additional observations.

Independent claim 24 requires that the packaged set of floor panels include "at least two types of individual floor panels" having different lengths which are "configured to form together at least part of one and a same floor covering." The claims also require that these separately sized floor panels have coupling parts which "cooperate with one another for forming the floor covering."

The applicant has previously argued that while *Meckstroth* teaches that the structural panels may be provided in different widths or lengths, there is no suggestion by *Meckstroth* of taking the unobvious step of the pending claims to provide a set of floor panels having different lengths in a single box, as required by the amended claims. Instead, *Meckstroth* merely indicates that the panels may be prefabricated in different widths or lengths (col. 2, lines 50-55). It has therefore been submitted that there is no indication that these differently sized panels in *Meckstroth* may be provided in a set for forming one and the same floor covering.

The limitations of claim 24 inherently require that these differently sized first and second types of floor panels have coupling parts which couple with one another so as to form the one and same floor covering. *Meckstroth* teaches differently sized panels but the rejection does not show or suggest how these panels combine with one another to form a one and single floor covering and are packaged in a set together in a single box, as currently recited in claim 24.

In observing *Meckstroth*, it is readily apparent that the passage relied upon in the rejection (col. 2, lines 50-55) merely conveys that panels of different dimensions may be produced according to different applications such as “depending on whether the panels are intended for use as floor panels, wall panels, ceiling panels, or roof panels.” From this passage, without the benefit of the pending application, one skilled in the art would understand that depending on the particular application, the structural panels will have a certain dimension. For example, the structural roof panels may have a certain width and length, whereas the structural floor panels may have a certain width that is different from the roof panels.

Extending the reasoning of the action, the rejection appears to assert that a manufacturer of the panels of *Meckstroth* would package these differently sized panels together despite the fact that their dimensions are particularly tailored for different applications. Thus, the skilled carpenter would receive a package of panels having 2 feet, 4 feet, 6 feet, etc., which are suited for use in different applications such as floor panels, wall panels, ceiling panels. Because the panels are in different sizes, the skilled carpenter building a roof would likely be left with an assortment of panels of *Meckstroth* which are too small (i.e., 2 feet) or too large (i.e., 6 feet) for the

particular application, and quickly run out of panels (i.e., 4 feet) hypothetically best suited for the roof.

Therefore, the skilled person would not readily recognize from *Meckstroth* the inventive step of packaging a plurality of different types of floor panels for forming part of one and the same floor covering in a single box.

Claim 24 clearly requires that the differently sized panels be provided in a set for forming one and the same flooring covering, and that the set of panels is packaged in a single box. It is submitted that *Meckstroth* clearly does not advise the skilled artisan of doing anything more than merely providing differently sized structural panels, and does not motivate the skilled artisan to take the unobvious step of packaging the set of panels in a single box, as mandated by the amended claims.

Further, it appears in the action that the rejection relies on the assumption that the differently sized panels of *Meckstroth* are necessarily provided together in a single package and arranged to couple with one another for the same application. The applicant respectfully disagrees. “[R]ejections on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness” *In re Kahn*, 441 F.3d 977, 988 (Fed. Cir. 2006). (Also cited in *KSR Int’l Co. v. Teleflex Inc.*, 127 S.Ct. 1727, 1741 (2007)).

The applicant finds no articulated reasoning to modify the differently sized structural panels of *Meckstroth* to form one and the same floor covering while being packaged together in a single box. Indeed, as pointed out above, the panels of *Meckstroth* are provided in different widths and lengths depending on their defined application. One of ordinary skill in the art would not reasonably consider the differently sized panels of *Meckstroth* as consisting of or relating to a packaged set in a box arranged to form one and a same floor covering.

Claim 24 requires that the first and second types of floor panels have different decors which are formed by decorative paper soaked in resin. As depicted in Figs. 5 and 6 of the specification, this limitation indicates that the first and second types of floor panels will have a decor different from one another, which are at least due in part to the fact that they have different lengths.

The action provides no evidence of a set of floor panels having first and second types with different decors. Indeed, the action readily acknowledges that the outer skin of the panel in *Meckstroth* is plywood, and is obviously not of a decorative paper layer soaked in resin.

As for *Sugar*, this reference likewise fails to disclose or suggest a set of floor panels having first and second types of different decors formed from a decorative paper layer. Instead, the decors are formed by artificial stone or the like (1:9-12).

*Haffner*, which is relied upon in the action for its decorative layer, does not convey the understanding to the skilled person to provide first and second types of floor panels having both different lengths and different decors.

Taking the teachings of *Sugar* and *Haffner* together, there is no evidence that the skilled person would understand from *Sugar* to configure the decorative layers in *Haffner* with different decors.

*Hendrich*, which is relied upon in the action for the teaching of packaging panels for transportation, does not suggest to the skilled person the concept of floor panels of different lengths being packaged in a single box. Contrary to the assertion in the action that the skilled person would have appreciated packaging panels in “any convenient, efficient and low cost manner,” it is submitted that the skilled person would not understand packaging panels in a single box from *Hendrich* because *Hendrich* describes large-scale, interconnected (via hinged joints) structural panels which are particularly used as building modules (i.e., floor panels – not a floor covering, side wall panels, and roof elements).

The panels of *Hendrich* are of a magnitude that the skilled person would readily recognize as being unsuited for packaging in a single box. Particularly, at

least in reference to claim 35, the skilled person would not understand from *Hendrich* to provide floor panels having different lengths in that a first type of floor panel having a first length spans the length of the box, and the second and third type of floor panels (of different lengths) are arranged in the box at the same level and have second and third lengths which combine to span the entire length of the box (i.e., combined length the same as the first length).

The rejection also appears to continue to indicate that *Fahy* teaches providing floor panels of different sizes in a set. The appellant respectfully disagrees. While *Fahy* discusses the fact that the floor panels may be in different sizes (col. 1, lines 40-46; col. 5, lines 23-34), there is nothing in *Fahy* that would motivate one skilled in the art to provide such differently sized floor panels in a set for one and the same floor covering. Instead, *Fahy* just discusses the fact that floor panels have different sizes and the problems associated with the differently sized panels. *Fahy* does not describe the unobvious step of a providing a set of floor panels in a single box.

It will be noted that the rejection's reliance on the depiction in Fig. 13 of floor panel 10/50 having a different length than adjacent floor panel 10A/50A is misplaced. The view of 10A/50A is only a sectional view, as pointed out in Col. 4, lines 22-24, and does not represent the notion of providing floor panels of different lengths.

Accordingly, there is no disclosure in *Fahy* of providing differently sized floor panels in a set for one and the same floor covering.

Thus, *Fahy* does not make up for the shortcomings of *Meckstroth*, and hence none of the references cited in the rejection instruct the skilled artisan to take the unobvious step of providing a set of panels for forming one and the same floor covering with differently sized panels from a single box in which these panels are packaged.

With regard to dependent claim 33, the applicant respectfully disagrees that it is mere design choice to establish the ratio of length relative to the width of the floor panel. In fact, it is one of the objectives of the invention to provide a technical means which allows for the minimization of an unnatural appearance of laminate flooring in one and the same floor covering. The specific length-to-width ratio recited in claim

33 provides a technical solution to allow for the minimization of the unnatural appearance so as to provide a laminate floor covering having a better plank-like floor appearance.

The particular limitations of claim 24 and the combination thereof with the length-to-width ratio of claim 33 greatly contribute to a plank-like appearance of the claimed set of floor panels. For example, claim 24 particularly recites that the panels have different lengths, which in turn due to the different lengths, the joints at the short edges do not repeat at regular distances and an unnatural regular staggering pattern is avoid. In another example, claim 24 recites that the panels of different lengths are packaged in one box, which automatically provides a good mix of panels of varying lengths that can be used together to form a floor covering that more closely simulates a real, plank-like floor appearance.

In the view of these observations, it is submitted that the proposed combination of *Meckstroth*, *Haffner*, *Hendrich* and *Fahy* fails to render the pending claims *prima facie* obvious since these references taken as a whole and in combination fail to teach every feature required by the pending claims. Moreover, there is no suggestion among these references or rationale articulated in the rejection which shows that one skilled in the art would be motivated to make the proposed combination to devise the set of packaged decorative floor panels according to the pending claims.

Accordingly, withdrawal of the rejection is respectfully requested.

4. Rejection of claim 35 under 35 U.S.C. § 103(a) as being unpatentable over U.S. patent 3,641,730 (*Meckstroth*) in view of U.S. patent 6,863,768 (*Haffner*), U.S. patent 4,479,333 (*Hendrich*) and U.S. patent 6,256,952 (*Fahy*) and further in view of U.S. patent 5,403,055 (*Allison*)

Reconsideration of this rejection is respectfully requested in view of the amendment to claims 24 and 35 which describes the set of floor panels as being “packaged,” and the preceding remarks on the rejection based on the combination of *Meckstroth*, *Haffner*, *Hendrich* and *Fahy* of claim 24 from which claim 35 depends, and following observations on *Allison*.

In the action, *Allison* is relied upon to show that it was known to arrange building panels at a same vertical level in a package so as to span the entire length of the package. However, it will be noted that claim 35 requires more than such a proposition, as articulated in the action. Instead, claim 35 particularly requires that a panel of a first type of panel spans the length of a box, and that a floor panel of each a second and third type of panels, which are described as having different lengths, are arranged in the box at a same level so as to combine to span the entire length of the box.

Nowhere in *Allison* is there any particular understanding of a packaged set of panels packaged in the manner required by claim 35. Indeed, while the action refers to Figs. 4, 6 and 7 of *Allison* as teaching the basic limitations of claim 35, these figures appear to only describe panels, logs and roof trusses of a single length, and not those of multiple lengths. Because the panels, logs and roof trusses described by *Allison* are of a single length, there is no specific understanding or even a suggestion of arranging panels of different second and third lengths along a same level in a box.

Thus, *Allison* fails to disclose or suggest every limitation for which it is included in the combination with *Meckstroth*, *Haffner*, *Hendrich* and *Fahy*. Likewise, *Meckstroth*, *Haffner*, *Hendrich* and *Fahy* fail to make up for the shortcomings of *Allison*.

Accordingly, the skilled person would not understand from the combination of *Meckstroth*, *Haffner*, *Hendrich*, *Fahy* and *Allison* the limitations of claim 35. Further, there is no evidence or rationale articulated on the record which shows that it was known to arrange panels of different second and third lengths along a same level in a box.

Withdrawal of this rejection is respectfully requested.



5. Conclusion

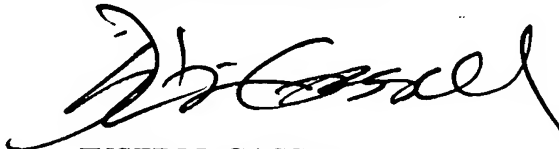
As a result of the amendment to the claims and the foregoing remarks, it is respectfully submitted that the application is in condition for allowance. Accordingly, it is respectfully requested that every pending claim in the present application be allowed and the application be passed to issue.

If any issues remain that may be resolved by a telephone or facsimile communication with the applicants' attorney, the examiner is invited to contact the undersigned at the numbers shown below.

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Respectfully submitted,

A handwritten signature in black ink, appearing to read "Justin J. Cassell", written in a cursive style.

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